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58

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

HILLERY, NATHAN

ART UNIT	PAPER NUMBER
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2176

DATE MAILED: 06/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/734,045

Applicant(s)

GORELICK ET AL.

Examiner

Nathan Hillery

Art Unit

2176

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 March 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5, 7 and 9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5, 7 and 9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is responsive to communications: RCE filed on 3/17/05.
2. Claims 1 – 5, 7, and 9 are pending in the case. Claims 1 and 9 are independent.
3. The rejection of claims 1 – 5, 7, and 9 under 35 U.S.C. 103(a) as being unpatentable has been withdrawn as necessitated by amendment.

Continued Examination Under 37 CFR 1.114

4. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 1/18/05 has been entered.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1, 3, 4, and 9 rejected under 35 U.S.C. 102(e) as being anticipated by Rodkin et al. (US006092074A).

7. **Regarding independent claim 1**, Rodkin et al. teach that *the content server 410 may provide hypertext links only for character strings in the on-line article 405 which match a local database of stored character strings at the content server, and/or which have no corresponding destination address. If a character string in the on-line article 405 does not match the database of stored character strings or has no corresponding destination address, no link is provided* (Column 12, lines 43 – 49) and that *the Intelligent Annotator™ 520 may insert the destination address itself, e.g., a URL ... into the article to be annotated* (Column 19, lines 33 – 36), which provide for **comparing the text to one or more character strings contained in a database in order to identify specific character strings from the database that appear in the text, wherein each of the character strings has an associated hyperlink that is also contained in the database; and for each of the identified character strings contained in the text, inserting the associated hyperlink into the webpage**. Rodkin et al. teach that *advantageously, the present invention allows the destination addresses in the database 540 to be changed without changing the annotated article. That is, the destination address which is referenced by a given anchor code can be changed over time. For example, the anchor code for "quote" mentioned above may initially reference the destination address "http://www.quotes.com" which is provided by Company A. However, a competing company, such as a stockbroker, Company B, may pay the central server administrator to update the master destination and expiration database 555 with the preferred destination address of Company B, e.g., "http://www.companyB.com". When the next periodic update of the content servers*

occurs, the central server 450 will transmit the updated destination address to the content server 410 for storage in the destination and expiration database 540. Then, the next time a Web surfer activates the anchor code for "quote" mentioned above, a link to the preferred destination address of Company B will occur (), compare with

designating a name for a product and storing the name of the product as one of the character strings in the database. Rodkin et al. do not explicitly teach

determining a topic. Sundaresan teaches that *the operation of the automatic mining system is performed in three stages: The first stage is carried out by a new terms discoverer for discovering the terms in a document d_i ; the second stage is carried out by a candidate terms discoverer for discovering potentially relevant terms; and the third stage is carried out by a relevant terms discoverer for refining or testing the discovered relevance to filter false (or insignificant) relevance (Column 3, lines 42 – 49) and that the new terms discoverer 90 defines the terms that need to be examined for their relevance to a target topic (or concept). As used herein a target topic can be defined as a description of the cluster of the topic's instances in a database. For a given target topic and a database of HTML documents discovering a relevant topic is to discover a topic whose cluster significantly overlaps with the target topic's cluster. In other words, a significant number of the relevant topic's instances belong to the target topic's cluster. The significance is determined by a user-defined threshold. In the illustration described herein, relevance is defined in terms of co-occurrence of terms (Column 7, lines 37 – 49), which provide for*

automatically determining a topic of the text, wherein the character strings are automatically selected from the database based upon the

topic. It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the invention of Rodkin et al. with that of Sundaresan because such a combination would allow the users of Rodkin et al. the benefit of *an automatic mining system to discover terms that are relevant to a given target topic from a large database* (Column 3, lines 34 – 36).

8. **Regarding dependent claims 3 and 4,** Rodkin et al. teach that *a computer user viewing the page can access the referenced document simply by selecting the highlighted text in the instant file, e.g., by clicking on the highlighted text with a mouse or other pointing device. A markup language anchor, or markup language hyperlink, is the reference icon on a Web page which links a user's Web browser to relevant information. An HTML anchor, or HTML hyperlink, is the underlined text on a Web page which links a user's Web browser to another location.* (Column 1, lines 26 – 35) and that *in the above examples where it was indicated that a content server administrator input 530 may be used, generally such input is optional as the present invention provides the capability for fully automatic insertion of hypertext link codes into the article to be annotated* (Column 20, lines 55 – 59), which provide that **the hyperlinks are inserted into the text of the webpage and for reconfiguring computer code used to form the webpage such that the identified character strings change appearance and the associated hyperlink is selectable by a user that selects and clicks on the identified character strings.**

9. **Regarding independent claim 9,** the claim incorporates substantially similar subject matter as claim 1, and is rejected along the same rationale.

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 2, 5, and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rodkin et al. (US006092074A).

12. **Regarding dependent claim 2**, Rodkin et al. do not explicitly teach that **the text comprises content of a newsgroup article**. However, Rodkin et al. do teach that *the content server 410 processes an on-line text article 405 using an executable Intelligent Annotator.TM. 412 to automatically associate hypertext anchor codes with various character strings in the article. A resulting on-line article with hypertext 415 can be produced and stored locally on the content server 410* (Column 12, lines 31 – 36). It would have been obvious to one of ordinary skill in the art at the time of the invention to be motivated to use the invention of Rodkin et al. on newsgroup articles so that the users can process all types of on-line text articles including newsgroup articles.

13. **Regarding dependent claim 5**, Rodkin et al. do not explicitly teach **communicating the name of the product to a producer of the text**. However, Rodkin et al. do teach that *the method may comprise the further steps of receiving designated character strings ... wherein the designated character strings are designated by an administrator input at the primary computers; updating the annotation database with the designated character strings if the designated character strings are not present in the*

annotation database (Column 10, lines 25 – 32). It would have been obvious to one of ordinary skill in the art at the time of the invention to be motivated to use the invention of Rodkin et al. to designate a product to producers, by administrator input, so that the producers could provide their readers with further information about their product.

14. **Regarding dependent claim 7**, Rodkin et al. do not explicitly teach that **only the first occurrence in the text of the character string is hyperlinked**. However, it would have been obvious to one of ordinary skill in the art at the time of the invention to be motivated to use the invention of Rodkin et al. in that way because the skilled artisan would not want the user to believe that the other occurrences in the text of any character string are different links from each other and the first occurrence; thereby, allowing the user to checkout the other links and not have to constantly revisit links that the user has already seen.

Response to Arguments

15. Applicant's arguments with respect to claims 1 – 5, 7, and 9 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nathan Hillery whose telephone number is (571) 272-4091. The examiner can normally be reached on M - F, 10:30 a.m. - 7:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph H. Feild can be reached on (571) 272-4090. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 2176

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

NH



SANJIV SHAH
PRIMARY EXAMINER